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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,560	07/30/2003	Janusz Jachowicz	FDN-2805	8640

EXAMINER	
VENKAT, JYOTHSNA A	

ART UNIT	PAPER NUMBER
1615	

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INTERNATIONAL SPECIALTY PRODUCTS
Attn: William J. Davis, Esq.
Legal Department, Building No. 10
1361 Alps Road
Wayne, NJ 07470

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,560

Applicant(s)

JACHOWICZ ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/25/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of election filed on 12/11/06 and 6/8/07. Applicants elected species of formula II wherein Z is phosphate. The species elected belonging to I and II and IV, **wherein Z is phosphate is not described in the instant specification**. Therefore restriction between the species is withdrawn. Claims 1-49 are pending in the application and the status of the application is as follows:

The filing date of the instant application is 7/30/03 and the art cited below are competent references.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1. **This is a written description rejection.**

This is a “written description” rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. *Vas-Cath Inc. V. Mahurka*, 19 USPQ2d 1111, states that applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention, for purposes of the “written description” inquiry, is “*whatever is now claimed*” (see page 1117).

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A review of the language of the claim indicates that these claims are drawn to a genus, *i.e.*, “cosmetic removal agent... heating balm”.

A description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). In *Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The court indicated that, while applicants are not required to disclose every species encompassed by a genus, the description of the genus is achieved by the recitation of a representative number of species falling within the scope of the claimed genus. At section B (1), the court states “An adequate written description of a DNA ... requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention”. Hence, an adequate written description of the ingredients requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984). Applicant fails to adequately describe the specific compounds in each category of claim 46. There is no single species of the claimed genus disclosed that is within the scope of the claimed genus.

The disclosure of a single disclosed species may provide an adequate written description of a genus when the species disclosed is representative of the genus. However, the present claim encompasses numerous species that are not further described. One of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus drawn to skin altering composition using various agents that are claimed in claim 48.

The courts have stated:

“ To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention. *Lockwood v. American Airline, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gosteli* 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“ [T] he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”). Thus an applicant complies with written description requirement “ by describing the invention, with all its claimed limitation, not that which makes it obvious,” and by using “ such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood v. American Airline, Inc.*, 107 F.3d at 1572, 41 USPQ2d at 1966; *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder* 736 F.2d 1516, 1521, 222 USPQ 369, 372-373 (Fed. Cir. 1984). Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of various agents in claim 48 and the specification does not reasonably convey to one skilled in the relevant art the

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inventor(s), at the time the application was filed has possession of the entire scope of the invention drawn to "skin altering composition and which further contains a cosmetic removal agent, a skin stimulating agent, a depilatory agent, an astringent, a skin abrading agent, a wrinkle mollifying agent, a moisturizing agent, a sun blocking agent, a skin soothing or healing balm and mixtures thereof".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of various agents of claim 48 ca not be determined from the disclosure

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 19-24, 42, 44 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/058649 translated text provided by applicants ('649).

See pages 4-6 for the claimed cationic polymer formed from a, b and c and see page 6 for the species of cationic polymer and these are same as species claimed in claim 8, see page 6 for the ranges, average molecular weight and see page 6 for fixing polymer and see pages 7-17

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which reads on the different fixing polymers claimed in claims 19-23, see page 17 for additives claimed in claim 44 and see the examples. All the components are same and therefore the composition will have the claimed pH of claim 42.

Claims 1-14, 25-29, 35- 44, and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/058,660 translated text provided by applicants ('660).

See pages 5-7 for the claimed cationic polymer formed from a, b and c and see page 7 for the species of cationic polymer and these are same as species claimed in claim 8, see page 7 for the ranges, average molecular weight and see page 7 for oxidizing agent, see page 8 and page 9, lines 1-10 for the oxidizing agent, see pages 9-16 for the cationic polymer and this reads on the conditioning agent (12-13) and also cationic polymer of claim 35 and see pages 17-22 for amphoteric polymer (claims 35-39), see page 22 for anionic surfactant, see page 23-24 for cationic, non ionic and amphoteric surfactant and this reads on claims 40-41 and 44, see page 8, fifth paragraph for acids and bases and this reads on claims 44,45-47, see examples for sequestering agents (claim 44). All the components are same and therefore the composition will have the claimed pH of claim 42. WO document also anticipates claim 48, since the claim is drawn to composition and the expression "intended for bleaching or permanent waving" is for future intended use.

Claims 1-14, 25-29, 35- 48 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/058,648 translated text provided by applicants ('648).

See pages 4-6 for the claimed cationic polymer formed from a, b and c and see page 6 for the species of cationic polymer and these are same as species claimed in claim 8, see page 6 for the ranges, average molecular weight and see pages 6-9 for dyes (claims 32-34), see page 26, 4th

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and 5th paragraph for the oxidizing agent, see pages 10-17 for the cationic polymer and this reads on the conditioning agent (12-13) and also cationic polymer of claim 35 and see pages 17-23 for amphoteric polymer (claims 35-39), see page 23 for anionic surfactant, see page 24-25 for cationic, non ionic and amphoteric surfactant and this reads on claims 40-41 and 44, see page 26, last paragraph and page 27 first and second paragraph for acids and bases and this reads on claims 44,45-47, see examples for sequestering agents (claim 44). All the components are same and therefore the composition will have the claimed pH of claim 42. WO document also anticipates claim 48 since claim 48 is drawn to composition and the expression “intended for bleaching or permanent waving” is for future intended use.

Claims 1-14, 16-18, 30-31, 35- 48 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/058,661 translated text provided by applicants ('661).

See pages 5-7 for the claimed cationic polymer formed from a, b and c and see page 7 for the species of cationic polymer and these are same as species claimed in claim 8, see page 7 for the ranges, average molecular weight and see page 7 for reducing agent (claims 30-31), see pages 8-15 for the cationic polymer and this reads on the conditioning agent (12-13) and also cationic polymer of claim 35 and see pages 15-21 for amphoteric polymer (claims 35-39), see pages 21- 23 for anionic surfactant, cationic, non ionic and amphoteric surfactant and this reads on claims 40-41 and 44, see examples for ammonium carbonate, ammonia and citric acid and this reads on claims 44,45-47, see example 1 for sodium ascorbate and this reads on claimed protective agent, which is antioxidant . All the components are same and therefore the composition will have the claimed pH of claim 42. WO document also anticipates claim 48 since

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claim 48 is drawn to composition and the expression “intended for bleaching or permanent waving” is for future intended use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WO document '661 and U. S. Patent 6,221,817 ('817).


WO document as explained above. WO document does not teach the limitation of claim 15, where in the conditioning agent is various silicone containing agents. WO document teaches cationic polymers and these are conditioning agents. Patent '817 teaches conditioning compositions using cationic polymers at col.8, ll 35 through col.9, ll 42 and at col.9, ll 45 through col.s 10-16 teaches various silicones as conditioning agents. Thus all these compounds are functional equivalents.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of WO and use conditioning agents, which are silicones. One of ordinary skill in the art would be motivated to substitute silicones for cationic polymers since all the compounds are taught as conditioning agents by patent '817. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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